

REMARKS

In response to the Office Action mailed November 5, 2004, Applicant amends his application and requests reconsideration. In this Amendment no claims are cancelled and new claims 28-32 are added so that claims 17-32 are now pending.

In this Amendment, an incorrect article at the beginning of claim 17 is corrected. Unnecessary limitations regarding the stopping of the reels and alignment of the lines for winning symbol combinations with the common axis of the reels are removed. These amendments are all supported by the application as filed, and particularly by claims 26 and 27.

A further limitation is added to claim 17 that specifies that each of the symbols of the plurality of symbols on the reel sheets appears on each of the individual reel sheets. This description is supported, for example, by Figure 1 of the patent application. A comparison of the reel sheets 100L, 100C, and 100R shows that every symbol appears, without exception, on each of the reel sheets. For example, the bell symbol 101 that appears in sequence without interruption on the reel sheet 100L also appears elsewhere without repetition on that reel sheet and appears without repetition on each of the other two illustrated reel sheets. Comparison to each of the other illustrated symbols and their appearances on all of the reel sheets shows that the added limitation is clearly supported by the application as filed. Claims 18 and 20 are amended to conform to the amendment of claim 17.

New claim 28 specifies that each of the symbols that is repeated on one of the reel sheets also appears on the other reel sheets, but is not repeated on the other reel sheets without an intervening different symbol. For example, referring again to Figure 1 of the patent application, the bell symbol appears on all three of the reel sheets but only as a repeated symbol on one of the reel sheets. The same situation is true for both the plum and cherry symbols. New claim 29 specifies that an award table, such as the award table of Figure 8, appears on a housing of the display where the award table can be consulted by the player. Therefore, the player knows the desired combinations to win a prize. Claim 29 is supported at page 14, lines 20-23 of the patent application. New claims 30 and 31 are derived from the unnecessary limitations removed from claim 17 regarding the straight lines. These claims are also supported by the disclosure supporting claims 18-20, particularly in Figures 2-7 of the patent application. Finally, new claim 32 is supported by the award table of Figure 8 of the patent application as further explained below with respect to the prior art rejection.

All examined claims were nominally rejected as unpatentable over Ugawa (JP 5-68733) in view of Hooker (U.S. Patent 4,184,683). This rejection is respectfully traversed. It is stated that the claims were rejected "nominally" over this combination of publications because the limitations of some claims were not, admittedly, disclosed in either of Ugawa or Hooker. Rather, "Official Notice" was cited as the basis for the rejection of certain claims. Every rejection based upon "Official Notice" is also respectfully traversed. To the extent any such rejections are maintained, Applicant requests that at least one prior art publication be cited, in place of the non-factual and non-prior art rejections founded upon "Official Notice". If such prior art publications are not cited, the "Official Notice" rejections must be withdrawn in view of this seasonable challenge.

Hooker was cited only with respect to describing a game apparatus that included rotating reels that could be stopped independently and selectively by a player of the apparatus. Claim 17 has been amended to eliminate reference to such a feature so that Hooker is no longer pertinent to any claim.

Ugawa describes an apparatus with three rotating reels including reel sheets having particular symbols arranged on the reel sheets according to Figure 22 of Ugawa. According to the English language abstract of Ugawa, the only winning combinations of the symbols include either the number 7 or a "bar" symbol which, in Figure 22 of Ugawa, resembles a crest with the word "bar" across the center of the crest. Therefore, whenever a bell symbol appears at any location of the display or whenever a watermelon appears at any position on the display, the player of the machine recognizes that a loss has occurred.

From an inspection of Figure 22 of Ugawa, it is apparent that Ugawa cannot meet the terms of amended claim 17. Every symbol of the plurality of symbols on the Ugawa reel sheets does not appear on each such reel sheet. For example, the watermelon symbol appears on the reel sheets for the center and right reels of Ugawa, but not for the left reel. Likewise, although the bell symbol appears on the left reel sheet and the center reel sheet, the bell symbol does not appear on the right reel sheet. Accordingly, Ugawa neither describes nor suggests the invention as defined by amended claim 17.

The difference between the invention as described in that claim 17 and Ugawa is more clearly understood with an explanation of the background of Ugawa. As described, but difficult to understand, in the English language abstract of Ugawa, in a previously known machine, a combination of symbols might appear that represents a loss according to some award table. However, to an inexperienced game player, the combination might indicate a winning state. For example, in that prior apparatus, if three symbols appear in

the display window and those three symbols are all identical, a natural reaction is that a prize has been won. However, whether a prize has been won depends upon not whether the symbols match each other but whether the combination of the symbols is a “winning” combination or a “losing” combination. The inexperienced game player reacts negatively upon realizing that no prize has been won, because of the initial reaction that a prize must have been won. That player is discouraged from continuing to play the game machine.

Ugawa describes one solution to the negative reaction of an inexperienced game player by assuring that, for example, there can never be an alignment of identical “losing” symbols that represent a losing combination. However, in Ugawa there can be an alignment of identical “winning” symbols, a combination that provides a prize. Therefore, when an alignment of three identical symbols is achieved, a winning state has occurred and an inexperienced player is not misled. Further, the inexperienced player recognizes that when the three symbols do not match, even if one of the symbols might be a “winning” symbol, that a winning state has not been achieved.

Ugawa provides one of the simplest possible solutions to avoiding an alignment of identical non-winning symbols by assuring that one of those non-winning symbols is absent from one of the three reels. This solution is directly contrary to the present invention in which all of the symbols appear on all of the reel sheets and reels. Moreover, according to the disclosure of the present patent application, as shown by the award table of Figure 8 and as recited in new claim 32, every alignment of identical symbols without interruption by a different symbol provides a winning state. Thus, the problem to which Ugawa is addressed is not present in the invention as defined by the claims presented here. Moreover, since Ugawa does not suggest the arrangement described in the claims presented here, claims 17-32 are clearly patentable over that publication, considered with or without Hooker.

Claim 18 describes an arrangement in which the display window provides three straight lines for viewing the symbols when the reels stop rotating. Claim 18 further specifies that a specific combination of symbols that provides a winning state may appear on any of those three lines. Such an arrangement is not shown nor suggested in either of Ugawa or Hooker. Hooker, admittedly, shows three symbols on each of three reels in a window. However, it appears that only the center line of the three potential horizontal lines of symbols in Hooker, opposite the unexplained arrows 33, provides a winning combination. There simply is no disclosure in Hooker on this point and it would be improper and speculative to rely on Hooker as allegedly disclosing a potential for

achieving a winning state on each of three different lines of displayed symbols. Thus, claim 18 is patentable independent of the patentability of claim 17.

Claim 20 was rejected based upon "Official Notice". That claim specifies that a winning state can be achieved by alignment of winning symbol combinations along any of three lines that might be parallel to the common axis about which the reels rotate, but also might be diagonal lines that are oblique to that axis. While the Examiner asserted that such an arrangement is known in the gaming art, Applicant respectfully disagrees. If the rejection is to be maintained, then a prior art publication showing that such an arrangement to establish a win state is known in the gaming arts must be provided.

Claims 21 and 26 explain the arrangement of the symbols on the reel, in accordance with the example provided in the patent application with regard to Figure 1. Referring to that figure, three reel sheets attached to corresponding reels are shown. In the left reel sheet 100L, the symbol that is arranged sequentially is the bell symbol. In the center reel sheet 100C, the repeated symbol represents a plum. In the reel sheet 100R, the repeated symbol is a group of cherries. It can be seen by reference to the award table of Figure 8 that a number of winning combinations may occur when the bell appears in the leftmost position in the display window. Likewise, at least one of the winning combinations may appear when the plum is present at the center portion of the display window. However, no specific combination results in a winning state when the cherry symbol appears in the rightmost part of the display window.

In the described embodiment of the invention, upon actuation of the game that includes the display, each of reels, to which a corresponding reel sheet is attached, spins. The player of the game hopes each reel will stop so that a display of a specific combination of symbols, for example, one of the combinations shown in an award table of Figure 8, will result. When one of those combinations appears, the player wins a prize or receives an award, such as additional game free of charge. As explained in the patent application, by providing certain symbols in a repeated fashion on the reel sheets, the player has an easier time identifying a symbol as the reels are spinning. With respect to the leftmost reel sheet, the player hopes the reel will stop to display a bell symbol in the display. Of course, just the opposite is true with respect to the reel sheet 100R because the player wants to avoid stopping to display the repeated symbol, the cherries. The repeated symbol in the center reel sheet presents a still different situation from the other two reel sheets. There, the repeated symbol may or may not be a winner based on the symbols on the stopped left and right reels. In summary, stopping at the repeated symbol in the leftmost reel sheet is desirable, stopping at the repeated symbol in the center reel sheet may be neither desirable nor undesirable, but

stopping at the repeated symbol of the rightmost reel sheet is usually undesirable. This variety increases the entertainment value and attraction of the machine employing the claimed display.

No clear award table appears in the figures of Ugawa, but a win state requires a combination of only the numbers 7 and the bar symbols. Therefore, unlike the structure of amended claims 21 and 26, no reel in Ugawa includes a symbol appearing serially, without an intervening different symbol, that is part of a specific combination resulting in an award, i.e., a win state. Appearance of either a bell symbol or a watermelon symbol, the only symbols serially appearing without intervening different symbols, defeats any win state in Ugawa. Therefore, claims 21 and 26 clearly distinguish from Ugawa and any potential modification of Ugawa by Hooker.

Claim 24 was rejected based upon the “printed matter” doctrine with a citation to *In re Gulack*, 215, USPQ 491 (Fed. Cir. 1983). Applicant reminds the Examiner that *Gulack* held that the “printed matter” doctrine did not apply to the invention sought to be patented in the application that was the subject of that appeal. Here, the use of different colors of particular symbols on different reels has an interactive effect with the other symbols on the same reel. This positive interaction demonstrates, in accordance with the holding of *Gulack*, that the “printed matter” doctrine does not apply to claim 24. Claim 24 is allowable independent of the allowability of claim 17.

The limitation of new claim 28 is neither disclosed nor suggested by Ugawa, considered with or without Hooker. That claim requires that each of the symbols that is repeated on one of the reel sheets also appears on each of the other reel sheets. Referring to Figure 22 of Ugawa, it is apparent that the bell symbol repeated in the leftmost reel sheet does not appear at all in the rightmost reel sheet. Moreover, the serially repeated watermelon symbol appearing in the rightmost reel sheet of Figure 22 of Ugawa does not appear at all on the leftmost reel sheet. Claim 28 is clearly novel and not obvious in view of any potential combination of Ugawa and Hooker, independent of the status of claim 17.

New claim 29 concerning the display of the award table for the assistance of the game player recites a feature not present in either of Ugawa or Hooker, thereby demonstrating that claim 29 is patentable regardless of the patentability of claim 17.

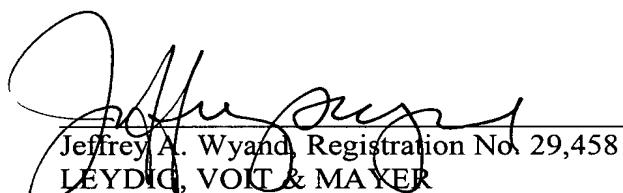
New claims 30 and 31 are patentable as depending from a patentable claim. Further, as already noted with regard to claim 20, neither Ugawa nor Hooker discloses the limitations of claims 30 and 31. Moreover, “Official Notice”, without a prior art publication, is not sufficient to establish *prima facie* obviousness of those claims.

In re Appln. of YASUYUKI SEKINE
Application No. 09/208,696

New claim 32 has already been discussed in connection with amended claim 17. Further, as already pointed out in discussing amended claim 17, in Ugawa, the only alignments of identical symbols that can produce a winning state are the symbols 7 and the bar symbols. Moreover, it is impossible to provide a display along a straight line of three identical symbols in Ugawa, other than those winning symbols, because of the arrangement of the losing symbols on the reel sheets of Ugawa. Therefore, Ugawa not only fails to disclose the limitation of new claim 32, the disclosure of Ugawa teaches against a structure like that of new claim 32. Claim 32 is clearly patentable separately from claim 17.

Reconsideration and allowance of all claims now pending are earnestly solicited.

Respectfully submitted,



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